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EXAMINER

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHEKHAR KIRANI and VENKAT V. EASWAR

Appeal 2007-1989
Application 09/588,875
Technology Center 2100

Decided: January 16, 2008

Before JAMES D. THOMAS, MAHSHID D. SAADAT, and
JAY P. LUCAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1 through 12, 14 through 19, 22 through 29, 31 through 36, 38 through 44, and 46 through 70. We have jurisdiction under 35 U.S.C. §§ 6(b) and 134(a).

As best representative of the disclosed and claimed invention, independent claim 1 is reproduced below:

1. In an online system, a method for providing digital photographic images to target devices, the method comprising:

receiving a request to provide a target device with a copy of a particular photographic image;

determining capabilities of the target device;

based on the capabilities of the target device, determining an image format that is desired for providing that target device with a copy of the particular photographic image;

generating a cache lookup key based on the identity of the particular photographic image and the image format that is desired;

determining whether a cached copy of the particular photographic image already exists in said determined image format using the cache lookup key;

if a cached copy exists, providing the target device with the cached copy of the particular photographic image;

if a cached copy does not exist, translating the particular photographic image into a copy having said determined image format; and

providing the target device with the copy having said determined image format.

The following references are relied on by the Examiner:

Jackowski	US 6,141,686	Oct. 31, 2000 (Filed June 23, 1998)
Foster	US 6,202,097 B1	Mar. 13, 2001 (Filed January 17, 1995)
Knight	US 6,289,375 B1	Sep. 11, 2001 (Filed October 30, 1998)
Stewart	US 6,389,460 B1	May 14, 2002 (Filed August 12, 1998)
O'Neal	US 6,411,685 B1	Jun. 25, 2002 (Filed January 29, 1999)
Huang	US 6,438,576 B1	Aug. 20, 2002 (Filed March 29, 1999)

All claims on appeal stand rejected under 35 U.S.C. § 103. In a first stated rejection, the Examiner relies upon Huang in view of Stewart as to claims 1 through 5, 7, 9, 11, 12, 14 through 19, 24 through 27, 31, 32, 36, 38 through 43, 46 through 53, 56 through 59, 62, 63, and 67 through 69. To this initial combination of references, the Examiner has added additional prior art in separately stated rejections. In the second stated rejection, the Examiner adds Foster as to claims 6 and 41; in the third stated rejection, the Examiner adds Knight as to claims 8 and 70; in the fourth stated rejection, the Examiner adds well known prior art as to claims 12 and 44; in a fifth stated rejection, the Examiner adds Jackowski as to claims 10, 22, 23, 54, and 55; in a sixth stated rejection, the Examiner adds Appellants' admitted prior art as to claims 28 and 60; and lastly, in a seventh stated rejection, the Examiner additionally relies upon O'Neal as to claims 29, 33 through 35, 61, and 64 through 66.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief (no Reply Brief has been filed) for Appellants' positions, and to the Answer for the Examiner's position.

OPINION

For the reasons set forth by the Examiner, as expanded upon here, we sustain each of the separately stated rejections of the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1996). "[T]he Examiner bears

the initial burden on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.3d 1443, 1445 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

From our review of the Examiner’s positions in the lengthy Answer, the Examiner appears to have complied with the requirements as to the combinability of the applied prior art. Moreover, at least with respect to the first through six stated rejections, Appellants’ argument beginning at page 15 of the Brief do not argue before us that the references are not properly combinable within 35 U.S.C. § 103. We treat the seventh stated rejection separately in the latter portion of this opinion.

As a general matter, Appellants’ arguments with respect to each of the separately stated rejections commonly argue the feature of the respective independent claims 1, 36, and 67 on appeal as best representative by the material quoted here from independent claim 1: “generating a cache lookup key based on the identity of the particular photographic image and the image format that is desired.” Essentially corresponding language appears in independent claims 36 and 67. At least with respect to the independent claims on appeal, since no arguments have been made before us as to any

other feature recited in these claims, any arguments that could have been made with respect to them have been waived.

As to independent claim 67 and its dependent claims 68-70, we observe in passing that the prolific use of the word “to” in the preamble and the body of claim 67 makes these claims subject to rejections under the second paragraph of 35 U.S.C. § 112. There is no present tense among the recited elements and the “system” of these claims since they recite future acts that may never occur. A potential infringer is thus left in a quandary as to how to avoid infringement; the noted recitations are not definite and the scope of the claims is not reasonably determinable. Even though these issues have not been raised by the Examiner or Appellants in this appeal, the applied prior art is thus more clearly applicable to claims 67-70 than is apparent.

Since we generally agree with each of the Examiner’s responsive arguments made beginning at page 18 of the Answer to those specific arguments raised in the Brief with respect to each stated rejection, we will only make general mention of them here. Since Appellants have noted at the bottom of page 14 of the Brief on Appeal that both Huang and Stewart discuss the use of caches, we find it unpersuasive Appellants’ general assertion at the bottom of page 15 of the Brief that Huang does not teach or suggest generating a cache lookup key at all. Clearly, for the artisan to appreciate the teachings of Huang to access the image data that is cached in this reference there must be some kind of broadly recited “key” used for retrieval purposes for Huang to access the data in his respective memory.

The argument at the top of page 16 of the Brief that Huang teaches away from using a cache lookup key based on an image format is misplaced as noted by the Examiner at pages 19 through 21 of the Answer. As essentially noted by the Examiner at the top of page 20 of the Answer, there is no stated portion in the arguments that Huang discourages following cache lookups utilizing image formats as set forth by the Examiner's reasoning and the teachings in Stewart or whether the artisan would be lead in a direction divergent from the path that was actually taken by Appellants. The Examiner's reasoning to enhance the teachings of Huang by the specific, additional refining teachings in Stewart is well-grounded in the art relied upon as well as the Examiner's reasoning.

We agree with the Examiner's separate discussion at pages 21 and 22 of the Answer as to the separate positions with respect to dependent claim 7 at page 17 of the Brief. Page 22 of the Answer addresses the concerns raised by Appellants as to claims 17 and 49 at page 17 of the Brief. The various discussions beginning with the Background of the Invention of Huang as well as the general discussion even at column 3 in the Summary of the Invention of Huang clearly indicate to the artisan that the determination must initially be made based on the type or nature of the receiving client or target device type before the rendering process would proceed according to Huang's teachings. As to the separate arguments related to claims 17 and 49 at page 17 of the Brief, of claims 18 and 50 at page 18 of the Brief and of claims 31, 32, and 62 at page 19 of the Brief, we agree with the Examiner's views expressed with respect to these arguments at pages 22 and 23 of the

Answer. Finally, no arguments are presented to us in the Brief as to any other claim within the first stated rejection.

As to the second stated rejection, of Appellants' arguments at page 20 of the Brief, as noted earlier, do not argue before us that Foster is not properly combinable within 35 U.S.C. § 103 with Huang and Stewart. Moreover, as also noted earlier, the feature actually argued is with respect to the subject matter that is commonly recited in independent claims 1 and 36 on appeal and not any specific feature associated with dependent claims 6 and 41. Corresponding observations are made with respect to the remaining third through sixth stated rejections argued beginning at page 21 of the Brief. We note here that the additionally relied upon patent to Knight applied by the Examiner in the third stated rejection to claims 8 and 70 is not discussed with respect to the subject matter of dependent claim 70. What is argued with respect to the urging associated with claim 8 is really the subject matter of claim 7 which has not been rejected in this rejection but has been addressed separately in the first stated rejection.

The fourth stated rejection relates to dependent claims 12 and 44 where the Examiner relies upon well known prior art in addition to the combination of teachings of Huang and Stewart. The actual subject matter presented commonly among these claims is that the photographic image is "an artwork." We agree with the Examiner's observation at page 24 of the Answer that Appellants have not argued against the merits of the rejection with respect what was alleged by the Examiner to be well known in the art when the rejection was stated and, therefore, that Appellants impliedly admitted that the subject matter in the rejection was well known in the art at

the time the invention was made. The reasonable inferences argument criticizing the Examiner's position at page 22 of the Brief is also misplaced since the Examiner's reasoning, on which the rejection is based at pages 11 and 12 of the Examiner's Answer, relies upon Official Notice which has not been timely challenged by the Appellants. Moreover, whether a photographic image may be considered "artwork" is subject to subjective understandings by the reader/viewer. This term relates to data content considerations which are effectively non-functional descriptive material and are therefore not given any patentable weight to begin with.

As to the fifth and sixth stated rejections argued at pages 23 and 24 of the Brief, Appellants do not appear to argue the actual rejections the Examiner made as to the respective claims at issue, in addition to arguing again the features of the respective independent claims 1 and 36 on appeal which have already been addressed in the first stated rejection. The requirements of the respectively rejected claims are not asserted to not be present in the applied prior art. With respect to the fifth and sixth stated rejections, they do not rely upon the respectively added prior art for the teachings of the use of cache systems as argued. The Examiner relies upon the combined teachings of Huang and Stewart as to these features.

Lastly, as to the seventh stated rejection argued at pages 24 and 25 of the Brief relating to the additional reference to O'Neal, we strongly agree with the Examiner's observations at the bottom of page 24 of the Answer that O'Neal is not utilized by the Examiner for determining a format that is desired for rendering an image at a target device but rather is utilized for his teachings of determining user preferences for a target device, which builds

upon and enhances the teachings already relied upon by the Examiner in Huang and Stewart. Following these references, O'Neal is thus seen as reasonably pertinent to problems with which Appellants were concerned. Moreover, the actual recitations of dependent claims 33 through 35 and 64 through 66 are not argued specifically here anyway. As to the commonly recited features in dependent claims 29 and 61, there is no positive statement in either of these claims that any user preferences are required to begin with since format selections are stated to be made at least in part based upon user preferences "if any" for rendering images at a target device. Claims 29 and 61 therefore may be properly interpreted as not including any user preferences at all.

In view of the foregoing, the decision of the Examiner rejecting all claims on appeal under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

JDT:pgc

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